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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,966	10/24/2003	Khader S. Abdel-Hafez	3359-Z	6973

7590 04/05/2005

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EXAMINER

TRIMMINGS, JOHN P

ART UNIT

PAPER NUMBER

2133

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/691,966	ABDEL-HAFEZ ET AL.
	Examiner	Art Unit
	John P Trimmings	2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-82 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 January 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This Office Action is in response to the applicant's amendment dated 1/25/2005.

Claims 8 and 18 were amended by the applicant.

Claims 1-82 are pending.

Response to Amendment

Objections to Drawings (paragraph 1 of Previous Office Action)

1. In view of the applicant's proposed changes to the drawings, the following figures are approved: 2A, 2B, 2C, 2D, 2E, 3A, 3B, 3C, 4C, 4D, 4F, 4G, 4I and 4J.
2. In view of the applicant's proposed changes to the drawings, the following figures are maintained as being objected to, because the applicant failed to correct the reference characters in the description: 4A, 4B, 4H, 5C, 5D, 5E and 5F.

Objections to Drawings (paragraph 2 of Previous Office Action)

3. In view of the applicant's proposed changes to the drawings, the examiner withdraws the objections to the drawings based on paragraph 2 of Previous Office Action.

Objections to Claims

4. In view of the applicant's change to Claim 18, the examiner withdraws the objection to said claim.

Objections to Specification

5. In view of the applicant's changes to the disclosure, re: pages 11 and 16, the examiner withdraws the objections to said pages.

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6. The amendment is objected to because of the following informalities: page 27 of the amendment is missing. The examiner notes that the missing page in the amendment is part of the record in the original application submission, and so the missing page has not hindered the prosecution of this case. Appropriate correction is required.

7. In view of the applicant's non-responsiveness re: page 48, the examiner maintains the objection to said page.

8. In view of the amendment to the Abstract, the examiner withdraws the objection to the Abstract.

Claim Rejections - 35 USC § 112

9. In view of the amendment to Claim 9, the examiner withdraws the rejection of this claim under 35 USC § 112 second paragraph.

Response to Arguments

10. Applicant's arguments, filed 1/25/2005, have been fully considered but they are not persuasive.

As per Claims 1-16:

The applicant argues on page 45 of the amendment (in re: independent Claim 1) that the Ahanin reference is "flawed on its face", but the examiner disagrees. Firstly, the Ahanin prior art (Figure 1) was used only as reference to show the inner workings of the invention of Ahanin based on prior art, which served the examiner in teaching some of the applicant's claim. The examiner went on to use Figure 2 for asynchronous circuit

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teachings in order to complete the rejection of Claim 1. The quote of Ahanin by the applicant on page 45 of the argument (the flaw), is in reality Ahanin's motivation for inventing the asynchronous controlling circuitry in his invention, and so the applicant has taken Ahanin out of context, and there is no flaw in the reference.

In regard to the balance of the argument re: Claim 1, the applicant states that many features of the specification are absent in Ahanin, it is noted that the features upon which applicant relies (i.e., defects as per pages 7 & 8, "two pins", global_SE and global_SR_EN) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

And, the examiner maintains that clause (b) is taught, and in particular; capturing a test response of all said scan cells (FIG.2 120) for testing said faults propagated to said data ports (FIG.2 DA, DB) and said asynchronous set/reset ports (NPRESET/NCLEAR) of all said selected scan cells by enabling or disabling all said set(NPRESET)/reset(NCLEAR) enable signals (PRESET and CLEAR DISABLE) connected to all said selected scan cells during a capture operation (Ahanin, column 5 lines 1-11).

As per Claims 17-30:

The applicant argues (in re: Claim 17) as in Claim 1 above that many features of the specification are absent in Ahanin. It is noted that the features upon which applicant relies (i.e., defects as per pages 7 & 8, "two pins", global_SE and global_SR_EN) are not recited in the rejected claim. Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner maintains that a plurality of control inputs are used (see above paragraph).

As per Claims 31-82:

As in the above paragraphs for Claims 1-30, the applicant relies on features not stated in Claims 31, 47, 59 and 71, such as "two pins", global_SE and global_SR_EN. Additionally, the reference used by the examiner (FIG.2D) is discredited by the applicant because the applicant's circuit of FIG.2D has an inherent race condition. The examiner has adhered to and has utilized the advantage of the reference, and did not have to adhere to any purported disadvantage, and so was thus motivated to combine the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Trimmings whose telephone number is (571) 272-3830. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Trimmings
Examiner
Art Unit 2133

jpt



GUY J. LAMARRE
PRIMARY EXAMINER